REMARKS

I. Disposition Of The Claims

Claims 1-40 and 48-51 are pending. Claims 5-6, 11-40 and 49-51 were withdrawn from consideration. Office action, para. 7. Claims 1-4, 7-10 and 48 were rejected. Claims 1, 2 and 4 were objected to as written. Office action, para. 5-6.

The withdrawn claims should be rejoined. MPEP §§ 803.02; 821.04.

Claims 1, 3-4 and 7 have been amended as shown. Support is in the specification as filed.

II. Objections To The Claims

Claims 1, 2 and 4 were objected to based on various formalities. Each rejection is addressed under a separate heading.

A. Claims 1 And 4

Claims 1 and 4 were objected to because punctuation was required between the alternative hetero and carbocyclic rings. Office action, para. 5. The present version of the claims avoids the issue. This objection should be withdrawn.

B. Claim 2

Claim 2 was objected to under 37 CFR § 1.75 "as being a substantial duplicate of claim 1." Office action, para. 6. The objection stated that the term "non-immunosuppressive" in claim 2 was not "afforded critical weight." Office action, para. 6. This error makes the objection improper.

There is nothing inherently wrong with functional language. MPEP § 2173.05(g). Functional language, just like any other claim language, must be evaluated and considered for what is fairly conveyed to a person of ordinary skill in the art. MPEP § 2111.01. In this case, the term "non-immunosuppressive" must be evaluated and considered for what is fairly conveyed to those of ordinary skill in the art. It was not. Thus, this objection is improper and should be withdrawn.

III. Rejections Under 35 USC § 112, Second Paragraph

Various claims were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicants regard as the invention.

A. Claim 3

Claim 3 was rejected as it allegedly lacks antecedent basis for recited species which do not belong to the genus of formula (I) in claim 1. Office action, para. 1(a). According to the rejection, claim 3 recites species of substituted pyrazolidinecarboxylate or perhydropyridazinecarboxylate "in which the ring N is substituted with –C(=O)-O-, and not –C(=O)-C(=O)-R_2 as presented in formula (I) of claim 1." Office action, para. 1(a). The rejection failed to identify any rejected species.

It is respectfully submitted that the rejected compounds of claim 3 have antecedent basis. Thus, the rejection should be withdrawn.

If the rejection is maintained, please identify the allegedly improper species so that the issues may be efficiently resolved.

B. Claims 7-10

Claim 7 was rejected as indefinite because it recites the term "affecting." Office action, para. 1(b). The rejection stated that the metes and bounds of the claim allegedly cannot be determined because it is not clear whether "affecting" means increase or decreasing or normalizing a neuronal activity. Claims 8-10 were rejected as depending from a rejected claim. Office action, para. 1(c). These rejections are improper and should be withdrawn.

Where the scope of the claims, when reading light of the specification, would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. MPEP § 2173.02. The claim language need not be any more precise than the subject matter requires. MPEP § 2173.05(a). In this case, the PTO easily ascertained the meaning of "affecting." Office action, para. 3(b). Moreover, the breadth of a claim cannot be equated with indefiniteness. MPEP § 2173.04. Accordingly, these rejections are improper and should be

withdrawn.

C. Claim 48

Claim 48 was rejected as it allegedly was not clear what formulations, such as powder, tablet, syrup, or suspension, were intended. Office action, para. 1(d). Claim 48 was further rejected as it allegedly was not clear what proportions are needed. Office action, para. 1(d). These rejections are improper and should be withdrawn.

Where the scope of the claims, when reading light of the specification, would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. MPEP § 2173.02. In this case, the PTO easily ascertained some of the claimed pharmaceutical compositions. Office action, para. 1(d). The breadth of a claim cannot be equated with indefiniteness. MPEP § 2173.04. Thus, these rejections are improper and should be withdrawn.

IV. Rejections Under the Doctrine of Obviousness-Type Double Patenting

Claims 1-4, 7-10 and 48 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,417,189 (US '189). Office action, para. 3-4. The PTO stated its position in paragraphs 3-4 of the Office action.

Applicants respectfully request that the PTO hold this rejection in abeyance until such a time as allowable subject matter is indicated.

V. CONCLUSION

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned attorney by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date 08-11-2004

By _____

FOLEY & LARDNER LLP
Customer Number: 29728

29728
PATENT TRADEMARK OFFICE

Telephone: (202) 295-4166
Facsimile: (202) 672-5399

Sean A. Passino
Attorney for Applicants
Registration No. 45,943

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office

on 08-11-2004
Date

(45943)
SEAN A. PASSINO

002.1244503.2